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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/554,075	09/06/2006	Marco Mario Tivelli	2585-0129PUS1	2845
2292 7590 12/09/2008 BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747			EXAMINER SHEVIN, MARK L	
			ART UNIT 1793	PAPER NUMBER
			NOTIFICATION DATE 12/09/2008	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 10/554,075	Applicant(s) TIVELLI ET AL.	
	Examiner Mark L. Shevin	Art Unit 1793	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 October 2008 and 24 October 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 9 and 10 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 and 11-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 October 2005 is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>10/24/2005</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status and Restriction

1. Claims 1-20, filed as a preliminary amendment on October 24th, 2005, are pending. Claims 9 and 10 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention. Applicant timely traversed the restriction requirement in the reply filed on October 10th, 2008.

Applicants assert (p. 2, para 1) that it would be efficient, not burdensome for the Examiner to consider the merits of all the claims at this time.

In response, the Examiner notes that restriction under the lack of unity rules in this 371 case do not consider burden as a requirement for restriction.

Priority

2. The instant application is a 371 of PCT/MX03/00038, filed April 25th, 2003.

Information Disclosure Statement

3. The information disclosure statement (IDS) submitted October 24th, 2005 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement has been considered by the examiner. Please refer to applicants' copy of the 1449 form submitted herewith.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Joint Inventors

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. **Claims 1-4, 7, 8, 11-13, and 17-20** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Kondo** (JP 09-235,617).

Kondo:

Kondo, drawn to a method for manufacturing a high-strength, high toughness seamless steel pipe, discloses (claim 1) a steel composition as shown in the comparative table below:

Element	Kondo	Instant claims	Overlap
C	0.02 – 0.15	0.06 – 0.13	0.06 – 0.13
Mn	0.5 – 2	1.00 – 1.30	1.00 – 1.30
Si	0.1 – 0.15	0 – 0.35	0.1 – 0.35
P	0 – 0.05	0 – 0.015	0 – 0.015

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S	0 – 0.01	0 – 0.003	0 – 0.003
Mo	0 – 1.5	0.1 – 0.2	0.1 – 0.2
Cr	0 – 1.5	0.10 – 0.30	0.10 – 0.30
V	0 – 0.3	0.050 – 0.10	0.050 – 0.10
Nb	0 – 0.08	0.020 – 0.035	0.020 – 0.035
Ni	0 – 2.5	0.30 – 0.45	0.30 – 0.45
Al	0.001 – 0.5	0.015 – 0.040	0.015 – 0.040
Ti	0 – 0.08	0 – 0.020	0 – 0.020
N	0 – 0.01	0 – 0.010	0 – 0.010
Cu	0 – 0.8	0 – 0.2	0 – 0.2
Fe	Balance	Balance	Balance

The seamless steel pipe is produced by hot piercing, followed by hot rolling with a finishing temperature of 800 - 1050 °C, maintaining the rolled tube in a furnace at between 850 - 1100 °C (paras 0058 – 0060), directly quenching the tube at a cooling rate (R) of at least $R \geq 10^{3.1}/t^{1.4}$, (where t is the tube wall thickness in millimeters) and then tempering at a temperature of $500 - 2.3t < T < 720 - 1.1t$ for tube of less than 30 mm thickness and $T < 720 - 1.1t$ for tubes of greater than 30 mm thickness (claim 1)

The heating at between 850 - 1100 °C after rolling is described as an austenitizing treatment as any ferrite that is formed is said to become austenite again during the treatment process (para 0063).

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As for the quenching process, Kondo teaches that the hot tube should be quenched by spraying both the inside and outside surfaces of the tube with water (para 0066).

Regarding claims 1 and 2, it would have been obvious to one of ordinary skill in seamless steel pipe-making, at the time of the invention, to form a seamless steel tube of the instantly claimed chemical composition with a reasonable expectation of success in possessing high mechanical resistance, good toughness, and good resistance to cracking as Kondo taught a seamless steel pipe with a composition that substantially overlaps each and every of the claimed composition ranges and is made by a substantially identical production process compared to instant claim 10.

In particular, it would have been obvious to one of ordinary skill in the art at the time of the invention to choose the instantly claimed ranges through process optimization, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. See In re Boesch, 205 USPQ 215 (CCPA 1980).

From MPEP 2112.01: Where the claimed and prior art products are identical or substantially identical in structure or composition, or are produced by identical or substantially identical processes, a *prima facie* case of either anticipation or obviousness has been established. *In re Best*, 562 F.2d 1252, 1255, 195 USPQ 430, 433 (CCPA 1977). "When the PTO shows a sound basis for believing that the products of the applicant and the prior art are the same, the applicant has the burden of showing

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that they are not." *In re Spada*, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990).

Lastly, with respect to the compositional formulas of claim 1, it is well settled that there is no invention in the discovery of a general formula if it covers a composition described in the prior art, *In re Cooper and Foley* 1943 C.D. 357,553 O.G. 177., 57 USPQ 1 17, *Taklatwalla v. Marburg*, 620 O.G. 685, 1949 C.D. 77, and *In re Pilling*, 403 O.G. 513, 44 F(2) 878, 1931 C.D. 75. In absence of evidence to the contrary, the selection of the proportions of elements would appear to require no more than routine investigation by those ordinary skilled in the art. *In re Austin, et al.* 149 USPQ 685,688. It would have been obvious to one of ordinary skill in the art to select alloy compositions fulfilling the claimed compositional relationships from the alloy compositional ranges disclosed by Kondo for the reasons cited above.

Regarding claims 3, 4, 7, 8, 11, 12, 13, 17, 18, 19, and 20, one of ordinary skill would expect the resistance to cracking, corrosion resistance, yield strength, ultimate tensile strength, elongation, toughness, and hardness to stem from the composition and microstructure imparted by the production process and as the rejection of claims 1 and 2 showed a substantially identical product made by a substantially identical process, one would expect similar mechanical and chemical properties to result.

5. **Claims 5, 6, and 14-16** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Kondo** (JP 09-235,617) as applied to claims 1-4, 7, 8, 11-13, and 17-20 above, in further view of **Howells** (H. Howells ad S.A. Hatton. Challenges for ultra-deep water riser systems, IIR, London, April 1997, 11 pages.)

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The disclosure of Kondo was discussed above, however Kondo does not teach the wall thickness of the seamless steel pipes that he produces.

Howells:

Howells, drawn to the impact of ultra-deep water on steel catenary riser systems (SCRs), teaches that the wall thickness of pipe is such a scenario is a result effective variable in the loading put on the floating platform and the presence of buckling or collapse at a given water depth (p. 1 and p. 2, p.6 - figures 1 and 2). As shown in figure 2, the deeper the water, the thicker the pipe walls must be to avoid collapse or buckling.

Regarding claims 5, 6, and 14-16, it would have been obvious to one of ordinary skill in seamless steel pipe-making, at the time of the invention, to form the pipe of Kondo into segments of 30 mm or more and even 40 mm or more as Howells taught the wall thickness of such steel pipes when used as steel catenary risers to be a result effective variable effective in the loading on the floating platform tethered to the SCR(s) and the presence of buckling or collapse at a given depth. It would have been obvious to one of ordinary skill in the art at the time of the invention to choose the instantly claimed ranges through process optimization, since it has been held that there the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. See In re Boesch, 205 USPQ 215 (CCPA 1980).

Conclusion

6. The art made of record and not relied upon is considered pertinent to applicant's disclosure:

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R. K. Aggarwal et al. Qualification of solutions for improving fatigue life at SCR tough down zone, *Deep Offshore Technology Conference*, November 8-10, 2005, Vitoria, Espirito Santo, Brazil, 12 pages.

A. Izquierdo et al. Qualification of Weldable X65 Grade Riser Sections with Upset ends to Improve Fatigue Performance of Deepwater Steel Catenary Risers. *Proceedings of the Eighteenth International Offshore and Polar Engineering Conference*, Vancouver, BC, Canada, July 6-11, 2008, p. 71.

Kondo – US 2008/0047635 A1 and US 2008/0219878 A1

Tenaris Newsletter for Pipeline Services, May 2003, p. 1-8.

Tenaris Newsletter for Pipeline Services, April 2005, p. 1-8.

R. Thethi and D. Walters. Alternative Construction for High Pressure High Temperature Steel Catenary Risers. *OPT USA*, September 2003, p. 1-13.

-- Claims 1-8 and 11-20 (All elected) are rejected

-- No claims are allowed

The rejections above rely on the references for all the teachings expressed in the text of the references and/or one of ordinary skill in the metallurgical art would have reasonably understood or implied from the texts of the references. To emphasize certain aspects of the prior art, only specific portions of the texts have been pointed out. Each reference as a whole should be reviewed in responding to the rejection, since other sections of the same reference and/or various combinations of the cited references may be relied on in future rejections in view of amendments.

All recited limitations in the instant claims have been met by the rejections as set forth above. Applicant is reminded that when amendment and/or revision is required, applicant should therefore specifically point out the support for any amendments made to the disclosure. See 37 C.F.R. § 1.121; 37 C.F.R. Part §41.37 (c)(1)(v); MPEP §714.02; and MPEP §2411.01(B).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark L. Shevin whose telephone number is (571) 270-3588 and fax number is (571) 270-4588. The examiner can normally be reached on Monday - Friday, 8:30 AM - 5:00 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy V. King can be reached on (571) 272-1244. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Mark L. Shevin/

/Roy King/

Supervisory Patent Examiner, Art Unit 1793

10-554,075
November 20th, 2008